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MAY 31 2007

OFFICE OF PETITIONS

In re Application of	:	
James Gregory Newell	:	
Application No.: 10/609276	:	DECISION ON
Filing or 371(c) Date: 06/27/2003	:	PETITION
Title of Invention:	:	
RECONFIGURABLE POWER	:	
HANDLING DEVICE	:	

This is a decision in response to the Renewed Petition Under 37 CFR 1.181, filed October 12, 2006. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the corrected Notice of Incomplete Reply (Nonprovisional), mailed February 23, 2004. A Notice of Incomplete Reply, mailed January 16, 2004, was withdrawn on February 23, 2004. Applicant was so notified in a Withdrawal of Previously Sent Notice, mailed February 23, 2004. Also mailed on February 23, 2004 was a corrected Notice of Incomplete Reply (Nonprovisional). The Withdrawal of Previously Sent Notice informed Applicant that the time period for reply runs from the mail date of the corrected Notice. No reply having been received, the Application became abandoned April 24, 2004.

The May 22, 2006 petition

Applicant filed a petition on May 22, 2006, wherein Applicant asserted that the Notice of Incomplete Reply, mailed January 14, 2004, was the first Notice Applicant had received regarding insufficient fees and that the Notice of Abandonment, which stated that the application had become abandoned for failure to reply to the September 23, 2003 Notice, was incorrect. Applicant requested withdrawal of the holding of abandonment.

October 6, 2006 Decision dismissing Petition

A Decision dismissing the May 22, 2006 petition was mailed October 6, 2006. The Decision informed Applicant that the application became abandoned by operation of law for failing to timely submit the fee. Accord 35 U.S.C. § 111(a)(4). Having failed to submit the required fees, the application became abandoned. Applicant was informed that the Notice of Abandonment does not affect the status of the application. In other words, while the Notice of Abandonment may have erred in stating the reason for abandonment, the application was nevertheless abandoned for failing to timely and properly reply to the Notice of Incomplete Reply and submit the required fees.

The present petition

Applicant files the present petition and (1) asserts that this Office failed to discuss Applicant's assertion that Mr. Wallace of the PTO reported to Applicant that "no outstanding issues remained"; (2) provides a copy of the November 17, 2003 letter from this Office requiring Applicant to submit \$385.00 filing fee and \$50.00 processing fee for processing a returned check, and (3) a letter from the prior attorney of record responding to the Notice by filing \$375.00 filing fee and \$65.00 late payment fee. Applicant asserts that the total submitted, \$440.00, was in excess of that required by this Office, \$435.00, which supports the statement by Mr. Wallace that no outstanding issues remained.

Applicant argues that the corrected Notice of Incomplete reply was mailed in error and should be withdrawn.

Review of Office records

A review of office records reveals that the application filing fee, \$375.00, was submitted via check by Applicant. The check was returned for insufficient funds. Thereafter, on December 29, 2003, Applicant submitted \$375.00 for the filing fee and \$65.00 for the late filing fee surcharge (total of \$440.00).

The filing fee was \$385.00. A fee due of \$10.00 remained to complete the application filing fee.

This Office mailed a Notice of Incomplete Reply (Nonprovisional) on January 16, 2004, requiring the balance due to complete the filing fee, \$10.00, and also required \$50.00 processing fee for processing the returned check.

The Office withdrew the January 16, 2004 Notice, and mailed a corrected Notice of Incomplete Reply (Nonprovisional) on January 16, 2004, requiring the balance due to complete the filing fee, \$10.00, and also required \$50.00 processing fee for processing the returned check.

On May 22, 2006, Applicant submitted \$60.00 with the petition.

Analysis

As to (1), Applicant is directed to 37 CFR § 1.2, Business to be transacted in writing, which states:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

As to (2) and (3), as demonstrated by Office records and as confirmed by the Attachment (f) filed with the present renewed petition, the filing fee and a late filing fee surcharge were submitted to this Office on December 29, 2003; however, the filing fee was deficient and the processing fee for the returned check had not been submitted.

Applicant asserts that the office communication mailed December 29, 2003 and referred to as Attachment (E), did not indicate that a late filing fee surcharge was due; however, Applicant is responsible for filing the complete application filing fees, and having failed to do so, this Office is required to charge a surcharge for late filing of the fees. Applicant may not shift the burden of the responsibility for abandonment of the application to this Office for failing to notify Applicant that a late filing fee surcharge was due, especially when the prior attorney submitted the late filing fee surcharge with the deficient filing fee. It is Applicant's responsibility to file a complete and proper application in the first instance.

The petition is dismissed.

Alternate Venue

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently \$750.00 for a small entity¹.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

¹ Applicant is further advised that a grantable petition under 37 CFR 1.137(b) requires, in addition to the petition and petition fee, the required reply, to wit, an acceptable appeal brief; a continuing application; a Request for Continued Examination ("RCE"), or a reply that places the application in condition for allowance.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


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